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09/818,006	03/27/2001	Merrill W. Harriman	SAA-0058	2027

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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,006

Applicant(s)

HARRIMAN, MERRILL W.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In response to the amendment filed 06/30/2003, claims 1-27 are pending.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are directed to a method and system for training a user of software programming a programmable logic controller, the title "Web-Based Factory Automation Training on Demand" does not reflect this.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis:

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful

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arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claimed invention falls within the technological arts.

Useful, Concrete and Tangible Analysis:

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the claimed invention fails to produce a concrete result. In order for a method to produce a concrete result there must be a reasonable expectation of success, or the result must be assured. The limitation "so as to provide the user solutions to the difficulties allowing the user to program the programmable logic controller" does not produce either a reasonable expectation of success or an assured result. Although the system is providing answers (within its best capabilities) to the user that are designed to overcome the current difficulty that the user has encountered there is no reasonable expectation that the user will be able to complete the programming on the programmable logic controller. In fact the "solutions" may only lead the user to encounter more difficulties or may not completely solve the user's problem, as there is no guarantee that the system may provide the proper solution for the user's situation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-11, 13-18, 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al (US 5535422) in view of Mustafa (US 2002/0059378 A1). Regarding claims 1, Chiang et al teaches a system and method for training a user on a software product, wherein the user is provided a training hyperlink option in response to the user encountering difficulties, or an error as in claim 3, with programming, and linking the user to customized training resources addressing the difficulties based on the information, so as to provide the user solutions to the difficulties (see col. 18: 65-67). Information is retrieved upon selection of the training hyperlink; see the description of the "Show-Me" features. The training hyperlink option provided in response to a request by the user (claim 2) is taught at col. 18: 55-57. The information comprising data indicating at least one part of the software being used by the user (claim 4) is taught at col. 19: 9-11.

Chiang et al fails to teach that information is communicated automatically over a communications network (claim 1), that training resources comprise materials are: presented at an internet web-site (claim 6), are multimedia presentations (claim 7), or a link to a customer service representative (claim 8), that the communications network is a secure network (claim 9) or a private internal network (claim 10), that the training resources are modifiable (claim 13) and can be modified without changes to the software (claim 14).

Mustafa teaches that a communications network for transferring help information in paragraph 04. The various networks and types of training materials are taught in paragraphs 28-30. The ability to modify the training resources without changing the product is taught in the description and use of the "client profile". Specifically, see paragraph 41, which discusses downloading updated information to the user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to update the features of the Chiang et al invention with the on-line features of the Mustafa invention so as to provide for a more diverse help feature.

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It is noted that neither the Chiang et al nor Mustafa inventions are directly drawn to the "software for programming a programmable logic controller". It is the examiner's position that the specific claimed application of the software is not a patentably distinguishing feature. It is old and well known in the art that various software packages may be used during the process of programming a programmable logic controller. The Chiang et al invention is drawn to providing help when a user encounters difficulties in a generic software program. It would be equally applicable to any software product. The Mustafa invention is drawn to a general help feature and not limited to any particular product. As such its use with a software application would be obvious to one of ordinary skill in the art.

Claims 15-18, and 20-24 are a system which corresponds in scope to the method claims 1-4, 6-11, 13 and 14, respectively, and are rejected for the same reasons.

Regarding claims 25 and 26, the limitations of these claims are taught in the "Monitoring User Actions" section of Chiang et al, see col. 15.

Regarding claim 27, the claim represents an intended use of the user device as it is disclosed in claim 15. It is the examiner's position that the computer system of Chiang et al is capable of performing this function.

5. Claims 5, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al (US 5535422) in view of Mustafa (US 2002/0059378 A1) further in view of Gardner et al (US 5239617). Chiang et al and Mustafa teach all the limitations of the claimed invention as shown above except for the information containing data indicating at least one particular error made by the user. Gardner et al clearly teaches this ability at col. 5: 4-9. It would have been obvious to one of ordinary skill in the art to combine the abilities of Gardner to point out a specific error with the inventions of Chiang et al and Mustafa so as to provide an intelligent help system which is tailored to the user's specific needs.

Response to Arguments

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6. The examiner notes that applicant has requested a copy of the provisional application to which Mustafa claims priority. A copy of the application-as-filed, the contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (Sec. 1.19(b)) from the Office of Public Records. The examiner has not provided a copy of the application.

7. Applicant's arguments filed 06/30/2003 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has argued that the Chiang reference fails to teach the "customized training resources " of the claimed invention. Further stating that the software of the instant invention does not perform the next step of the programming process. This limitation for the software application is not recited in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner wholly agrees that Chiang does not show information about a user's error/difficulties being communicated over a communication network. This argument is moot however, as the examiner has relied upon Mustafa for teachings of this limitation. Applicant has presented no arguments against Mustafa's teachings in regards to this limitation. With regards to applicant's assertion that Mustafa does not teach modifying the training resources or doing so while the software remains unmodified. The examiner has clarified how these limitations apply in the above rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Kathleen M. Christman


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